IN THE UNITED STATES PATENT OFFICE

Inventor:	Stephen Michael REUNING
Filing Date:	03 July 2001
Ser. No.:	09/897,826
Examiner:	Samuel G. RIMELL, Esq.
Art Unit:	2175

Honorable Commissioner of Patents
Post Office Box 1450
Mail Stop - Appeal Brief
Alexandria, VA 22313-1450

Rule 193(b)(1) REPLY BRIEF

This REPLY BRIEF is submitted in response to the Jan. 2004 EXAMINER'S ANSWER.

1 STATUS OF CLAIMS

Claims 1-19 are pending. The EXAMINER'S ANSWER vacates the rejections under 35 USC 112. Claims 1-19 now stand rejected under 35 USC 102(e) over MCGOVERN *et al.*

2 SUMMARY OF INVENTION

The summary of the invention provided in the APPEAL BRIEF describes the invention *vis* the art of record, and points out how the claims define the invention.

The EXAMINER'S ANSWER concedes that this is correct "a summary of the prosecution history." Curiously, the ANSWER urges the Board to ignore this, and to look to the SPECIFICATION pages 5 to 7. While SPECIFICATION pages 5 to 7 is informative, it does not compare the invention to the art of record, nor explain how the claims distinguish from the Examiner's art, as is required by the Office's rules.

3 ISSUES

The EXAMINER'S ANSWER vacates the Section 112 rejections,[1] allowing us to focus on anticipation by MCGOVERN.

---

[1] The Office record says the language of claims 9 and 16 encompasses extraction to "one level, multiple levels, or no levels at all." OFFICE ACTION (12 June 2002). Applicant agreed with the Office's interpretation.

4 THE REJECTION OVER MCGOVERN

Claims 1-19 stand rejected over MCGOVERN. The rejection must be withdrawn because (1) the Office has already found that the Applicant antedates MCGOVERN, and (2) the Office has already found that MCGOVERN fails to enable certain claim elements.

4.1 Collateral Estoppel

MCGOVERN is not new to the prosecution history. MCGOVERN had been reviewed by the Examiner and found to not bar the claims. MCGOVERN was evaluated as early as December 1999, and found to not bar the claims in October 2000. MCGOVERN has now been raised from the dead, for this appeal. The prosecution history shows, in relevant part :

DATE	EVENT
3 Dec 1997	Parent application filed
14 Dec 1999	MCGOVERN cited against application
1 May 2000	MCGOVERN cited against application
14 Jul 2000	RULE 131 AFFIDAVIT and REMARKS filed
24 Oct 2000	MCGOVERN rejection withdrawn
13 Jan 2001	OFFICE ACTION does not cite MCGOVERN
9 Feb 01	Appeal filed; MCGOVERN not in issue
3 July 2001	NOTICE OF ALLOWANCE explains why art fails to teach claimed invention
3 July 2001	CONTINUATION APPLICATION filed; MCGOVERN of record
12 Jun 2002	OFFICE ACTION does not cite MCGOVERN
21 Oct 2002	OFFICE ACTION does not cite MCGOVERN
19 Nov 2002	Appeal filed; MCGOVERN not in issue
21 Aug 2003	MCGOVERN cited against application

The EXAMINER'S ANSWER says that the Examiner's own factual findings, made of record in the agency's own records, now "cannot be considered" by the agency. This is incorrect.

AMENDMENT (23 July 2002) at page 1, lines 29-32 ("The Examiner's interpretation is correct; this is exactly what this phrase means.").

The EXAMINER'S ANSWER, however, now suggests a new definition, EXAMINER'S ANSWER at page 4, line 14-15, and, in so doing, mischaracterizes the record. The Board must work with the definition proffered by the Office in 2002 and used during the past several years of prosecution, not the one newly-proposed in the EXAMINER'S ANSWER. This should not be problematic, because the difference between one-level-only extraction and various-level extraction is not material to patentability over any reference of record.

In the immediate appeal, noone is asking a PTO employee to discuss anything; Applicant simply wants the Office to comply with the law and respect its own written record of factual findings.

Similarly, noone is debating whether or not "a certain reference or other particular evidence was considered." No one is debating whether or not MCGOVERN was considered; and the agency record shows the Examiner considered it, repeatedly. Similarly, the agency record shows that the "other particular evidence" at issue (the DECLARATION and REMARKS)[2] are undisputedly part of the agency's record, that the Examiner considered this particular evidence and, based on it, concluded the rejection over MCGOVERN is factually unfounded.

Similarly, noone is debating "whether or not the claim *would have been* allowed." The parent claims undeniably *were* allowed. *See* NOTICE OF ALLOWANCE (29 June 2001). The pending claims are directed to the same subject matter.[3] After ***eight years*** of prosecution, the Examiner has not disputed any of this, and MPEP Section 1701 does nothing to allow him to now do so.

4.2 The Applicant has already antedated MCGOVERN

Applicant antedated MCGOVERN with a RULE 1.131 DECLARATION (14 July 2000). That DECLARATION was filed ***four years ago***. Now, suddenly, the EXAMINER'S ANSWER says that the DECLARATION is objectionable as allegedly "not correlated to the claims of the present application." EXAMINER'S ANSWER (Jan. 2004) at page 6, lines 12-13.

As a procedural matter, the Examiner should not raise this new grounds of rejection for the first time in the EXAMINER'S ANSWER. *See* MANUAL OF PATENT EXAMINING PROCEDURE § 1208.01. (To the contrary, it should have been raised not later than the 12 June 2002 OFFICE ACTION.)

As a substantive matter, this factual assertion is baseless and incorrect. It is baseless because the EXAMINER'S ANSWER fails to provide any factual basis for this factual assertion at

---

[2] Copies of the DECLARATION and REMARKS were included with the SUPPLEMENTAL APPEAL BRIEF.
[3] *Cf.*: this is a continuation application, not C-I-P application.

all. To the contrary, the EXAMINER'S ANSWER avoids even attempting to point out which limitation(s) of which pending claim(s) is (are) not shown in the Declaration.

The factual assertion is incorrect because the DECLARATION itself, and the REMARKS accompanying it, clearly show how the DECLARATION supports the claimed invention. Significantly, on receiving the DECLARATION and the REMARKS four years ago, the Examiner withdrew the rejection over MCGOVERN.

4.3 MCGOVERN does not teach "a filter that can search a web page"

The EXAMINER'S ANSWER alleges that MCGOVERN "discloses a filter (col. 18, lines 51-67) ... to search for specific resumes in the database." EXAMINER'S ANSWER at page 3, line 16 *et seq*. I'm starting to feel like the Examiner and I are talking past each other. As I mentioned perhaps six times in the past eight years, the claimed invention does not require resumes at all, and does not require the resumes (nor the email addresses) be stored in a database. Assuming that MCGOVERN does "disclose[] a filter ... to search for specific resumes in the database," this is not the claimed invention.

The EXAMINER'S ANSWER similarly alleges that the resume used in MCGOVERN "is considered to be a web page by reason that it is converted into HTML format before storage in the company database (col. 17, line 16) and by additional reason that the resume can be displayed on the program running on a web browser (col. 7, lines 5-10)." EXAMINER'S ANSWER at page 3, lines 11 *et seq*. As noted above (and in the SPECIFICATION and in the various REMARKS filed to date), the claimed invention does not require resumes at all, nor a data base; to the contrary, the invention can find attractive employment candidates who do not bother to submit a resume at all, much less submit one to a resume database. (this is why the inventor calls it a "Candidate Chaser"). The claimed invention is thus more flexible than, and enjoys different utility than, MCGOVERN.

4.4 MCGOVERN does not teach an "e-mail address extractor that can extract an e-mail address from said web page"

MCGOVERN fails to teach "an e-mail address extractor that can extract an e-mail address from said web page." The EXAMINER'S ANSWER disputes this, alleging that "McGovern

et al. discloses an e-mail extractor at col. 18, lines 24-35. EXAMINER'S ANSWER at page 7, lines 4-7; *see* id. at page 3, line 20 *et seq*. This allegation is factually incorrect.

MCGOVERN, at col. 18, lines 24-35, says, "*a screen display 240 as shown in FIG. 35, with the email address of the candidate automatically appearing in the 'To:' section.*" This teaches a screen display; it does not teach email address extraction from a web page, nor address extraction from anything else, nor mention "extraction" at all.

The EXAMINER'S ANSWER is perhaps inferring that where an e-mail address automatically appears, this address must have been extracted from a web page. This inference is incorrect (there are various possible sources of the automatically-appearing email address). Further, the Board is reminded that to anticipate, the reference must ***enable*** the claim limitation; here, MCGOVERN, at col. 18, lines 24-35 does nothing to enable extraction.

5 SUMMARY

The Examiner is respectfully requested to issue Form PTOL-90 and acknowledge receipt of this Reply, *see* Form Paragraph 12.47, and forward this appeal to the Board for docketing.

This REPLY BRIEF is submitted within two months of the mailing date of the EXAMINER'S ANSWER and is thus believed timely filed.

Respectfully submitted,

Mark POHL, Reg. No. 35,325
PHARMACEUTICAL PATENT ATTORNEYS, LLC
55 Madison Avenue, 4th floor
Attention : Mark POHL (P 4014)
Morristown, NJ 07960-7397 USA
8 March 2004

Direct: *Mark.Pohl@LicensingLaw.Net*
☎ +1 (973) 984-0076

RECEIVED
CENTRAL FAX CENTER
MAR 0 8 2004

OFFICIAL

Please type a plus sign (+) inside this box →

PTO/SB/21 (08-00)
Approved for use through 10/31/2002. OMB 0651-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number	09/897,826
Filing Date	3 July2001
First Named Inventor	S. M. REUNING
Group Art Unit	2175
Examiner Name	Samuel RIMELL, Esq.
Attorney Docket Number	Diedre

ENCLOSURES *(check all that apply)*

- ☐ Fee Transmittal Form
  - ☐ Fee Attached
- ☐ Amendment / Reply
  - ☐ After Final
  - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/ Incomplete Application
  - ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Assignment Papers *(for an Application)*
- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation Change of Correspondence Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) _____
- ☐ After Allowance Communication to Group
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☑ Appeal Communication to Group *(Appeal Notice, Brief, Reply Brief)*
- ☐ Proprietary Information
- ☐ Status Letter
- ☐ Other Enclosure(s) *(please identify below):*

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Pharmaceutical Patent Attorneys, LLC 55 Madison Avenue, 4th floor, Morristown NJ 07960-7397 USA
Signature	
Date	See below date

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: see below date

Typed or printed name	Mark POHL, Reg. No. 35,325		
Signature		Date	08 March 04

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

PTO/SB/97 (08-00)
Approved for use through 10/31/2002. OMB 0651-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Certificate of Transmission under 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office

on 08 March 04
Date

Signature

Mark POHL, Reg. No. 35,325
Typed or printed name of person signing Certificate

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

The submitted papers are enumerated on the enclosed Transmittal Form, PTO Form SB/21.